

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. :	09/937,942	Confirmation No.: 8824
Applicants :	Royce W. Johnson	
Filed :	October 2, 2001	
TC/A.U. :	3761	
Examiner :	Stephens, Jacqueline F.	
Docket No. :	VAC.483.US	
Customer No.:	60402	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This request is being filed in connection with a Notice of Appeal.

Status

In the present application, claims 1, 2, 4, 5, and 7 are currently pending, of which claim 1 is in independent form. Claims 3, 6, and 8-11 have been previously cancelled. The Applicant respectfully requests reconsideration of this application in light of the remarks set forth below.

Rejection Under 35 U.S.C. § 103(a)

The Examiner rejects claims 1, 2, 4, 5, and 7 under 35 U.S.C. § 103(a) as obvious over U.S. Patent 6,071,267 (hereinafter "Zamierowski") in view of U.S. Patent 5,344,455 (hereinafter "Keogh"). (Office Action dated November 16, 2007, page 3).

In the Final Office Action dated November 16, 2007, the Examiner claims to rely on Keogh to show the "benefits" of grafting an agent onto a polymeric substance, but the only "benefits" that the Examiner identifies consist of using "blood-contacing[sic]

polymeric surfaces that do not promote red cell destruction and coagulation of blood." (Office Action dated November 16, 2007, page 3). These benefits are wholly unrelated to the Applicant's claims, and thus do not support the Examiner's *prima facie* case of obviousness.

The Examiner also opines that the Applicant cannot "show nonobviousness" by attacking individual references, citing In re Keller and In re Merck & Co. In both of these opinions, though, the courts first found that the Examiner had established a *prima facie* case of obviousness, and then held that attacking individual references was insufficient to rebut the *prima facie* case. Here, the Applicant is not attempting to rebut a *prima facie* case of obviousness. Rather, the Applicant has pointed out the deficiencies of the Examiner's findings and the fallacies of the Examiner's argument, thereby demonstrating that the Examiner has not established a *prima facie* case of obviousness at all.

Lastly, the Examiner defends the use of hindsight reconstruction, citing In re McLaughlin. Since McLaughlin was decided in 1971, both the Supreme Court and the Federal Circuit have repeatedly cautioned that examiners "must be cautious of arguments reliant upon *ex post* reasoning." See, e.g., *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007). As McLaughlin acknowledges, some hindsight reconstruction is probably inevitable in judging obviousness, but that hindsight becomes impermissible when the Examiner evaluates the Applicant's claims "part by part," using the Applicant's disclosure as a roadmap to find its prior art components." Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1337 (Fed. Cir. 2005). Here, the Examiner has not provided any reasonable explanation as to how or why a person having ordinary skill in the art of treating wounds would look to Keogh to address the deficiencies of Zamierowski. Consequently, the Examiner has engaged in impermissible reconstruction, and has therefore failed to state a *prima facie* case of obviousness.

Conclusion

In view of the foregoing, the Examiner has failed to state a *prima facie* case of obviousness using Keogh and Zamierowski. Thus, the Panel is respectfully requested to allow independent claim 1, as well as claims 2, 4, 5, and 7 that are respectfully dependent therefrom.

Applicants believe a fee of \$510.00 is due with the filing of this Pre-Appeal Brief. Credit Card Payment Form SB-2038, with a signature from an authorized cardholder, is enclosed. The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 19-3140. A duplicate copy of this paper is enclosed.

Respectfully submitted,

_____/Gerald T. Welch/
Gerald T. Welch
Reg. No.: 30,332

Date: _____ March 17, 2008 _____

For Applicants:
Kinetic Concepts, Inc.
Legal Department – Intellectual Property
P.O. Box 659508
San Antonio, Texas 78265-9508
Telephone: 210.255.6855
Facsimile: 210.255.6969